

**REMARKS**

Claims 1 through 19 are currently pending in the application.

This amendment is in response to the Office Action of April 27, 2005.

**Preliminary Amendment**

Applicants note the filing of a Preliminary Amendment on January 23, 2004, which filing was not acknowledged in the outstanding Office Action. Should the Preliminary Amendment have failed to have been entered in the Office file, Applicants will provide a true copy to the Examiner.

**35 U.S.C. § 102(b) Anticipation Rejections**

**Anticipation Rejection Based on Shimomura et al. (U.S. Patent 5,922,620)**

Claims 1 through 7 and 10 through 12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Shimomura et al. (U.S. Patent 5,922,620).

Claims 13 through 15, 18 and 19 were rejected under 35 U.S.C. § 102(e) as being anticipated by Shimomura et al. (U.S. Patent 5,922,620).

Applicant asserts that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Applicants assert that the Shimomura et al. reference does not anticipate the claimed inventions of presently amended independent claims 1 and 13 under 35 U.S.C. § 102 because the Shimomura et al. reference does not identically describe the elements of the claimed inventions in as complete detail as is contained in the claims. Applicants assert that the Shimomura et al. reference does not identically describe the elements of the claimed inventions of presently

amended independent claims 1 and 13 calling for “providing an etchant-dispensing apparatus having an inlet thereto for an etchant agent and a tubular member having at least one thin annular edge thereon to clean material from the wafer, placing an area of the wafer within an annular member of the etchant-dispensing apparatus, at least one thin annular edge of the annular member of the etchant-dispensing apparatus located adjacent a portion of the wafer to clean material from the wafer, aligning the wafer and the etchant-dispensing apparatus to clean material from the wafer, dispensing an etchant onto the area of the wafer using the etchant-dispensing apparatus to clean material from the wafer, and removing the etchant” and “providing an etchant-dispensing apparatus having a tubular member, an annular member having at least one thin annular edge thereon, and an inlet for etchant for selectively removing a material from a wafer, aligning at least one area of the wafer and at least a portion of the etchant-dispensing apparatus for selectively removing a material from a wafer, dispensing an etchant onto the at least one area of the wafer for selectively removing a material from a wafer, and removing the etchant using a portion of the etchant-dispensing apparatus for selectively removing a material from a wafer”. In contrast to the elements of the claimed inventions of presently amended independent claims 1 and 13, the Shimomura et al. reference merely describes the dispensing of a polishing slurry for a chemical mechanical planarization process. Such is not the claimed inventions. Therefore, presently amended independent claims 1 and 13 are allowable as well as dependent claims 2 through 12 and 14 through 19 therefrom.

### **35 U.S.C. § 103(a) Obviousness Rejections**

Obviousness Rejection Based on Shimomura et al. (U.S. Patent 5,922,620) in view of Iwashita et al. (U.S. Patent 5,722,875)

Claims 8 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura et al. (U.S. Patent 5,922,620) in view of Iwashita et al. (U.S. Patent 5,722,875). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 9 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura et al. (U.S. Patent 5,922,620) in view of Drill (U.S. Patent 6,190,236).

Applicants assert that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

Applicants assert that dependent claims 8, 16, 19, and 17 are allowable as they depend from allowable independent claims 1 and 13 respectively.

#### **Double Patenting Rejection Based on U.S. Patent No. 6,329,301**

Claims 1 through 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 through 22 of U.S. Patent No. 6,329,301. In order to avoid further expenses and time delay, Applicants elect to expedite the prosecution of the present application by filing a terminal disclaimer to obviate the double patenting rejections in compliance with 37 C.F.R. §1.321 (b) and (c). Applicants' filing of the terminal disclaimer should not be construed as acquiescence of the Examiner's double patenting or obviousness-type double patenting rejection. Attached is the terminal disclaimer and accompanying fee.

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Applicants submit that claims 1 through 19 are clearly allowable over the cited prior art.  
Applicants request the allowance of claims 1 through 19 and the case passed for issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James R. Duzan".

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